

## **REMARKS**

The indication of allowable subject matter in claims 12, 14, 15, and 16 has been noted with appreciation. These claims have now been placed in independent form by including all the limitations of prior claims except that in claim 12 the functional language in the last four lines of claim 7 have been omitted because it is believed that the structural features of original claims 7 and 12, all of which are still present, clearly distinguish the invention from the prior art and further that it is not necessary to rely upon the functional language to distinguish the invention from any of the prior art either singly or in combination. Accordingly, claim 12 as amended is believed to be in condition for allowance.

Claims 14, 15, and 16 which the Examiner acknowledged to contain allowable subject matter have now been amended by inserting all limitations of the base claim 13 and any intervening claims and should therefore be in condition for immediate allowance. Favorable consideration and allowance of claims 12 and 14-16 is therefore believed to be in order and is respectfully requested.

Claims 4, 5, and 6 have now been made dependent on allowable claim 14 and are believed to be allowable for the same reason as claim 14 and because they are more specific through the inclusion of additional elements. Allowance of claims 4, 5, and 6 is therefore believed to be in order and is respectfully requested.

Claims 1-3 and 7-11 have now been canceled.

Claim 13 was rejected as unpatentable over Wassel in view of Scott.

The Examiner correctly noted that the upper edge of the slate blackboard 12 of Scott is retained by the lower side of the strip 5. However, there is a marked distinction in holding an element in place with the lower edge such as the lower edge of the strip 5 which holds the slate

blackboard 12 in place and the applicant's problem of compressing applicant's transparent sheet 12, the graphic material 14 and the backer board 26. The problem results because these 3 sheets extend as shown in applicant's Figure 5 upwardly into the slot 28 in the frame 7. In distinct contrast, the blackboard sheet 12 of Scott projects rearwardly and does not extend into a slot at the top. Consequently, the lower edge of his strip 5 can contact the outwardly projecting upper edge of the blackboard strip 12 as clearly shown in Scott Figure 3, but because applicant's three sheets of material 12, 14, and 26 as shown in Figure 5 extend upwardly into the slot 28, the lower edge of applicant's strip 18 can in no way apply pressure as in Scott which states that, "--- the slate blackboard 12 whose upper edge is retained by the lower side of the strip 5." (Emphasis supplied) By contrast, applicant has devised a different construction and a method of operation; a method that is different from both Wassel and Scott, that operates in a new way to produce a different result, namely, "a front surface that applies forward pressure to the rear surface portion of a backer board that extends downwardly out of a slot in the frame." (Emphasis supplied)

The Examiner will note that since the blackboard 12 of Scott projects rearwardly, with its upper edge exposed and not in a slot, the lower edge of this strip can contact the upper free edge of a rigid blackboard. Consequently, Scott would have no incentive to use a front surface of a hanger bar to apply forward pressure to a rear surface as claimed. The Examiner should also note that the Scott construction would not work for applicant's purpose since the upper edges of applicant's three sheets 12, 14, and 26 are hidden in the slot 28. Thus, the lower edge of applicant's strip 18 is not able to apply pressure in the manner described by Scott. Moreover, a person viewing Wassel would have no incentive to use the construction of Scott since, as clearly shown in Wassel Figures 3 and 5, the upper edges of the sheet material are sunk forwardly into

the picture frame. Consequently the lower edge of Scott's hanger 5 could not contact the back of any of the sheets, their upper edges being inaccessible.

Claim 13 has now been amended to provide:

- the frame including a downwardly facing slot therein holding an upper edge of the graphic sheet material, the sheet, and the backer board therein,
- front surface of the hanger member applying forward pressure to a rear surface portion of the backer board that extends out of the slot in the frame.

Claim 13 as amended is now believed to patentably distinct from the prior art. The allowance of claim 13 is therefore believed to be in order and is respectfully requested. Absent from the Examiner's combination of primary and secondary references are any suggestions to make the combination. Much less can there be found a reasonable expectation of success if the combination were to be made. This requirement is well established in the law, as set out in In re Mark A. Vaeck, 947 F.2d 488, 493, 20 USPQ 2d 1438, 1442 (Fed. Cir. 1991):

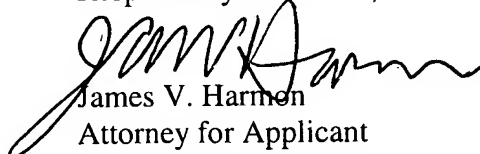
"Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under §103 requires, inter alia, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. [Citation omitted]. Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure." (Emphasis added).

The applicant submits that the above analysis applies to claim 13 and the other pending claims. Accordingly, the allowance of all uncanceled claims is believed to be in order and is earnestly solicited.

Claims 17 and 18 have now been made to depend from allowable claim 16 and are believed to be in condition for allowance for the same reason as claim 16 and because they are more specific through the inclusion of additional elements.

Favorable consideration and a prompt notice of allowance is believed to be in order and is respectfully requested.

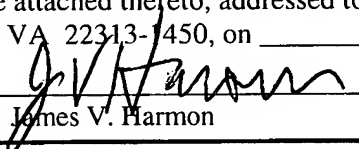
Respectfully submitted,

  
James V. Harmon  
Attorney for Applicant  
Registration No. 18,940  
(612) 339-1400

US BANK PLAZA Suite 2000  
220 South Sixth Street  
Minneapolis, MN 55402

**CERTIFICATE OF FIRST CLASS MAILING**

I certify this correspondence was deposited with the U.S. Postal Service, First Class Mail, with sufficient postage attached thereto, addressed to the Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on 3-15-05.

  
James V. Harmon

3-15-05  
Date

JVH/lts